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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,962	06/27/2003	Seiji Horie	019519-395	4849

7590

04/24/2006

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/606,962

Applicant(s)

HORIE ET AL.

Examiner

Callie E. Shosho

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1714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,3,10 and 11.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Callie E. Shosho
Primary Examiner
Art Unit: 1714

Attachment to Advisory Action

1. Applicants' amendment filed 4/6/06 has been fully considered but the amendment has not been entered given that it raises new issues that would require further consideration and search.

The amendment would raise new issues that would require further consideration under 35 USC 112, second paragraph.

Specifically, claim 1 has been amended to recite that the oil-based ink comprises colored resin particles "comprising core/shell particles, the core/shell particles comprising a core comprising a coloring component, wherein the coloring component comprises a pigment subjected to a surface treatment; and a shell layer comprising a resin component coating around the core wherein the shell layer is" obtained by dispersion polymerization of monomer (A) and monomer (B) with fine particles of the coloring component which are dispersed in a non-aqueous solvent as seed particles in the presence of a dispersion stabilizer. However, the scope of the claim is confusing because it is not clear how the shell layer is obtained by dispersion polymerization of monomer (A) and monomer (B) with fine particles of the coloring component which are dispersed in a non-aqueous solvent as seed particles in the presence of a dispersion stabilizer. That is, given that the dispersion polymerization is of monomer with fine particles of the coloring component, it would appear that such polymerization would result in the core/shell particle as a whole not just the shell layer.

Further, the amendment raises new issues that would require new searches given that the present claims now require that the colored particles comprise "core/shell particles". Previously, the present claims required colored resin particles obtained by dispersion polymerization of monomer (A) and monomer (B) with fine particles of the coloring component, however, there

was no requirement that the colored particles comprised “core/shell particles”. Such dispersion polymerization does not necessarily result in the formation of core/shell particles. That is, previously, the present claims were not limited to colored resin particles comprising core/shell particles. Thus, new searches would now be required given that the present claims do now require that the colored resin particles comprise core/shell particles.

Further, it is noted that even *if* the amendment were entered, while such amendment would overcome the 35 USC 102 rejection of record utilizing Takao et al. (U.S. 2002/0077383) as set forth in paragraph 3 of the office action mailed 1/6/06, the amendment would not overcome the 35 USC 103 rejection of record utilizing Kato et al. (U.S. 6,197,847) in view of EP 1205815 as set forth in paragraph 5 of the office action mailed 1/6/06.

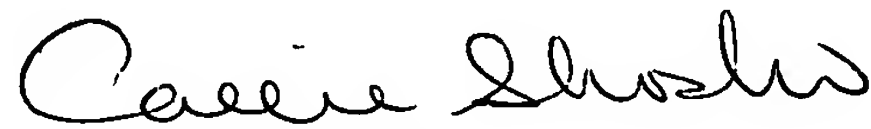
Applicants argue that there is no motivation to combine Kato et al. with EP 1205815 given that it is apparent that the surface treatment of the colorant particles in EP 1205815 pertains to the outermost surface of such colorant particles in the ink while in Kato et al., the surface of the colorant particles is not the outermost surface of the particles.

However, it is noted that the surface treated colorant of EP 1205815 is dispersed in organosol, i.e. core/shell polymer. Attention is drawn to paragraph 44 of EP 1205815 which discloses that the surface treated colorant is embedded in the organosol. Thus, EP 1205815 also discloses an embodiment, like Kato et al., wherein the treated surface of the colorant particles is not the outermost surface of the particles. Thus, given that the pigment subjected to surface treatment of EP 1205815 achieves beneficial effects when embedded in organosol or core-shell

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polymer, it would have been obvious to one of ordinary skill in the art that the pigment would also achieve such benefits when utilized as the core in the colored resin of Kato et al.

In light of the above, it is the examiner's position that even if the amendment were entered, the combination of Kato et al. with EP 1205815 would remain relevant against the present claims.



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CS
4/19/06